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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/096,560	06/12/1998	RAYMOND WALDEN BENNETT III	A00424(AMT-9	1956

7590 11/30/2004

Law Office of Dale B Halling
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COLORADO SPRINGS, CO 80903

EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 11/30/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

9

Office Action Summary

Application No.

09/096,560

Applicant(s)

BENNETT, III

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on October 1, 2002, **PROSECUTION IS HEREBY REOPENED**. New Ground of Rejection set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
 - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
 - (2) request reinstatement of the appeal.
3. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sizer, II, et al** in view of **Gorman** as stated by paragraph 4 of the Office action dated August 2, 2001.

Sizer, II, et al clearly disclose a home automation controller (*"appliance control means spaced from said premises recording means but within range of said generated packet transmission for interfacing with the premises appliance, said appliance control means including:*
means for receiving said packet of control information and being responsive to said information for controlling operation of the appliance;

means for generating a signal back to said premises recording means relating to appliance operation, wherein said premises recording means is responsive to said generated signal for transmitting further control information to said appliance control means; and

switch means operatively connected to said premises phone, said network and said premises recording means for switching said premises phone from communication with said telephone network over said first communication channel to control of said premises recording means using signals generated by said premises phone and sent over said control channel to said premises recording means for controlling transmission of control signals and thus controlling appliance operation by said premises phone, " and "wireless transmission means for generating and transmitting a packet of said control information in a signal to an appliance controller which is spaced from said premises recording means but within range of the generated packet transmission for controlling operation of the appliance via the generated signal, the packet having a transmission format including an address portion to identify a particular premises appliance and a data portion for said control information, wherein said premises recording means includes means for receiving a feedback signal generated from said appliance controller, said premises recording means being responsive to said generated signal for transmitting further control information to said appliance controller.") and Sizer, II, et al also disclose a security system which inherently must have a controller, ("It would also be desirable if such a unit

could also control other appliances within the premises so that the unit not only controls network functions in the premises phone, but also controlled other appliances contained within a premises, such as coffee pots, lights, and other appliances. A busy traveller coming in after a trip, or seated at a desk could quickly retrieve desired messages, as well as control various appliances within the home such as lights, coffee pots, toasters, stereos, security systems, thermostats and locks. ")Gorman disclose a home security controller, "Most preferably, the wireless distribution system operates in the higher 800 to 900 MHz frequency band now being used in a variety of consumer wireless applications such as the latest generation of wireless telephones, pagers, and the like. The preferred system is a digital communication system having multiple channel capacity to provide a plurality of POTS lines and lower speed data channel(s). Multi-channel digital wireless systems using time-division multiple access ("TDMA"), frequency-division multiple access ("FDMA") and spread spectrum techniques such as code division multiple access ("CDMA") feature provide greater bandwidth capacity and may be less prone to interference in electrically noisy environments such as the typical business office. The remote receiver may be a wireless handset or a fixed-wireless telephone station 55, similar to a conventional style telephone, except using an antenna and transceiver rather than a wireline to receive signals. The fixed-wireless telephone station may use battery or AC power and provide the telephony functions of receiving, transmitting, DTMF generation/detection, on and off-hook detection

and voice coding. Of course, all the features of conventional telephones such as wireless paging, intercom, speakerphone, security codes, volume controls, and the like may be incorporated. The wireless system may also have wireless headsets 56, wireless modems 57, or other home devices that are connected to receive lower data rate information, such as an alarm system 58.

"In another example, a kitchen counter display device 59 with a liquid crystal display may use a channel of the wireless distribution system 50 to access a recipe page on the Internet via a modem connection. To find a recipe, a user may use the kitchen display device 59 to connect to a host computer containing recipes, such as a web page on the Internet, using a lower speed data connection over the wireless distribution system 50. Preferably, the wireless distribution system 50 provides a lower speed data connection that uses a lower speed data connection from the ADSL modem 62. A data connection on the ADSL modem 62 has the advantage over a conventional telephone modem in that the ADSL modem 62 always has a data connection without having to 30 establish a new connection, i.e., a telephone call and connection does not have to be established for each call. Thus, a considerable amount of call setup time can be saved to allow quick access to information. It should be understood, of course, that a conventional facsimile, computer modems, wireless modems, paging systems, alarm systems and other lower speed data systems may also utilize the wireless distribution system.")

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

8. Claims 2-5 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sizer, II, et al** in view of **Gorman** in view of Office action dated August 2, 2001.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Sizer, II, et al** in view of **Gorman** as applied to claim 1 above, and further in view of **Storek, et al**.

Storek, et al teaches the use of a smart card interface (figure 1) "capable of " sending a plurality of instructions to a home automation controller. **Storek, et al** also teach that smart cards have been around since 1970's. Hence, it would have been obvious to one ordinary skill in the art at the time the claimed invention was made to incorporate the use of smart cards interface as **Storek, et al** in the home gateway system for home automation and security of **Sizer, II, et al** in view of **Gorman** as applied to claim 1 above, in order for a user to operate the system easily and securely.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

10. Claims 3-5 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sizer, II, et al** in view of **Gorman** as applied to claim 1 above, and further in view of **Launey, et al**.

Launey, et al teaches the use of voice processing system (figure 1, #10, 12, 58, 60, 64, 66, 62), a speaker verification module (#58, 66) and a speech recognition module (#58, 64) and the steps of operation (figures 7a-p) in a home gateway system for home automation and security. Hence, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to incorporate the use of voice processing system, a speaker verification module and a speech recognition module and the steps of operation, as taught by **Launey, et al**, in the home gateway system for home automation and security of **Sizer, II, et al** in view of **Gorman** as applied to claim 1 above, in order for a user to issue voice commands to the system.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

11. Claims 1, 3-6 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Launey, et al** in view of **Gorman**.

Launey, et al disclose all subject matter, note the home automation controller (figure 1, #10) and home security controller (figure 2, #36).. **Launey, et al** does not disclose the claimed wireless local loop transceiver. **Gorman** teaches the use of a wireless local loop transceiver "capable of" establishing a wireless local loop point link to a geographically separate non-mobile base station which is attached to the PSTN (figure 1, #30, 32, 34, 36, note paragraph 4, in the Office action dated August 2, 2001.) hence, it would have obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the use of a wireless local loop transceiver "capable of" establishing a wireless local loop point link to a geographically separate non-mobile base station which is attached to the PSTN, as taught by **Gorman** in the home gateway system of **Launey, et al**, in order to provide a local loop in places which does not have existing cable or telephone communication infrastructure.

Regarding 3-5 and 8-17, **Launey, et al** teaches the use of voice processing system (figure 1, #10, 12, 58, 60, 64, 66, 62), a speaker verification module (#58, 66) and a speech recognition module (#58, 64) and the steps of operation (figures 7a-p) in a home gateway system for home automation and security.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Launey, et al** in view of **Gorman** as applied to claim 1 above, and further in view of **Storek, et al**.

Storek, et al teaches the use of a smart card interface (figure 1) "capable of " sending a plurality of instructions to a home automation controller. **Storek, et al** also teach that smart cards have been around since 1970's. Hence, it would have been obvious to one ordinary skill in the art at the time the claimed invention was made to incorporate the use of smart cards interface as **Storek, et al** in the home gateway system for home automation and security of **Launey, II, et al** in view of **Gorman** as applied to claim 1 above, in order for a user to operate the system easily and securely.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Response to Arguments

13. Applicants' arguments filed January 7, 2002 have been fully considered but they are not persuasive.

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made.

Applicants' attorney traverse the Official notice state in the Office action dated November 20, 2000. To adequately traverse such a finding, an applicants' attorney must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("*[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.*"). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicants adequately traverse the examiner's assertion of official notice, the examiner must provide documentary evidence if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59

USPQ2d at 1697 ("*[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings*" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicants do not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. Applicants' attorney traversal is inadequate because:

{a} It was not timely. Applicants' attorney willfully and purposely did not traverse the Official notice in the next response (December 19, 2000 and again February 15, 2001) and did not seasonably challenge. In re Selmi, 70 USPQ 197; In re Fischer 52 USPQ 473; In re Boon, 169 USPQ 231.

{b} Applicants' attorney failed why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241.

{c} The examiner did provide documentary evidence.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction

based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art (*In re Sporck*, 155 USPQ 687). Attempt to invoke limitations present in the preferred embodiment but absent from the claims themselves violates the established claim construction principles.

The test for obviousness is not whether the features of the reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art (*In re Bozek*, 163 USPQ 545; *In re Richman*, 165 USPQ 509; *In re Beckum*, 169 USPQ 47; *In re Sneed*, 218 USPQ 385).

The reason, suggestion, or motivation to combine two or more prior art references in a single invention may come from the references themselves, from knowledge of those skilled in the art that certain references or disclosures in references are known to be of interest in a particular field or from the nature of problem to be solved, *Pro-Mold and Tool Company v. Great Lakes Plastics, Incorporated* 37 USPQ2d 1626.

There is no requirement, in finding the claimed invention obvious over combination of references, that the prior art must contain express suggestion to combine known elements to achieve claimed invention, since suggestion to combine may come from the prior art, as filtered through knowledge of one skilled in the art, Motorola, Incorporated v. Interdigital Technology Corporation 43 USPQ2d 1481.

Conclusion

14. Replacement Notice: Copies of Patent Application Records will be Provided in both Electronic and Paper Form

The Official Gazette notice, published on August 24, 2004 entitled "*All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form*" (1285 Off. Gaz. Pat. Off, August 24, 2004) is hereby rescinded. The USPTO is reinstating, until further notice, the procedures in effect prior to July 30, 2004 for providing certified copies of patent application records with paper certification statements. The USPTO will also offer electronic certified copies of patent application records at the requester's option.

Certified Copies with Paper Certification

Unless otherwise requested, certified copies of patent application records provided pursuant to 37 CFR 1.19 (b) will be produced with a paper certification statement, continuing the practice in effect prior to July 30, 2004. The certification statement will include an embossed seal and original signature.

Certified Copies with Electronic Certification

Customers ordering certified copies of patent applications as filed or patent-related file wrapper and contents of published applications from the USPTO website will have the option to choose electronic copies with electronic certification. These files include an imaged certification statement as part of a PDF file containing the document TIFF images. These electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. Customers may choose to download these electronic files from the USPTO website or receive them on compact disc.

Paris Convention for the Protection of Industrial Property and Priority

Irrespective of whether the USPTO provides a paper certified copy or an electronic certified copy, Article 4(d)(3) of the Paris Convention prohibits any country that is a member of the convention from requiring further authentication of the certified copy for purposes of claiming priority under the Paris Convention. (The text of the Paris Convention and a list of its members are available at www.wipo.int/treaties/en/ip/paris/index.html.)

The USPTO is working with other intellectual property offices to encourage the acceptance of priority documents in electronic form with electronic certification. A list of offices and international intellectual property organizations that have agreed to accept electronic certified copies will be posted on the USPTO website soon, and updated regularly.

Questions should be directed to the Office of Public Records by email to opr@uspto.gov or by telephone at (703) 308-9743.

15. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is **703-305-4394**. The examiner can normally be reached on Tuesday-Thursday, 11:00-8:30pm

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

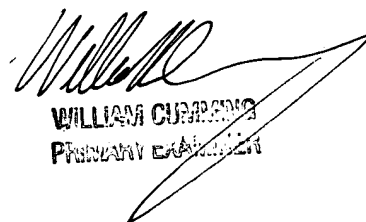
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Wdc



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